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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,025	12/29/2000	Jonathan W. Hubbs	29092.00011	7715

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EXAMINER

BRUNSMAN, DAVID M

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 08/27/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/751,025

Applicant(s)

HUBBS, JONATHAN W.

Examiner

David M Brunsman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-46 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The instant specification limits the invention to products that are firm, malleable enough to allow clear penetration and easy repair, resistant to being pulled up in clumps, dust free and water resistant.

Claims 37-40 and 42-46 fail to recite the required presence of wax and clay. Page 4, lines 4-5 of the specification discloses that in order to perform these functions the invention must comprise a mixture of wax and clay, sand or decomposed granite being a preferred additional ingredient. Every embodiment enumerated at page 4, lines 12-16 requires wax.

The Background teaches that other combinations of soil or clay and an organic binder fail to perform the functions required of the invention such that a significant number of combinations that otherwise fall within the scope of the claims are inoperable. See, *In re Cook*, 169 USPQ 451 and *In re Fisher*, 166 USPQ 18.

Page 6, lines 11-13 of the specification require that the particular wax used must be capable of making the surface malleable and add cohesiveness, suggesting that some waxes would be inoperative. The only teaching allowing one of ordinary skill in the art to determine which waxes are operable is the selection of the two particular waxes described in the Tables of

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pages 5 and 6. Without evidence that one of ordinary skill in the would expect most waxes to perform adequately or evidence the one would have been able to select operable waxes without undue experimentation the enabling scope of the disclosure is limited to waxes having properties similar to IGI 422 and IGI 1266U. Thus, in view of the evidence currently of record, claims 1-46 would fail to meet the enablement requirements of 35 U.S.C. 112, first paragraph.

Claims 13-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 13-36 depend from "the method of claim 12" or from a claim depending from "the method of claim 12". Claim 12 is drawn a surface material and not a method such that the scope and meaning of claims 13-36 cannot be determined.

Claims 37 and 38 recite a surface material having desired physical properties by do not recite any specific composition. Composition claims defined in terms of properties alone are indefinite. See, *Ex Parte Specht* 165 USPQ 409; *Ex Parte Slob*, 157 USPQ 172.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 37-39 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5961389.

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The reference teaches a surface material comprising a mixture of sand wax and fillers useful for recreational and sports surfaces. Because of the similar intended use, the composition would be expected to exhibit similar properties.

Claims 37-43 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 4925493.

The reference teaches a composition for surfacing horse racing tracks comprising soil made up of clay, sand and organic matter and wax. The sand recited is considered to be indistinguishable from decomposed granite. Because of the similar intended use, the composition would be expected to exhibit similar properties.

Claims 37-39 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5711795.

The reference teaches a moldable composition comprising sand and wax that is non-sticky, easily moldable and subsequently crushable by hand. This description would appear to fall within the density, compressible and shear strength recited by the instant claims.

The mere failure of a reference to disclose all the advantages asserted by applicant is no a substitute for actual differences in properties. In re DeBlauwe, 222 USPQ 191. An apparently old composition cannot be converted into an unobvious one simply by the discovery of a characteristic one cannot glean from the cited prior art. Titanium Metals Corp. v. Banner, 227 USPQ 773.

Accordingly, the burden of proof is upon applicant to show that the instantly claimed subject matter is different from and unobvious over that taught by the prior art relied

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upon. In re Brown, 173 USPQ 685, 689; In re Best, 195 USPQ 430; In re Marosi, 21 USPQ 289, 293.

Any evidence to be presented under 37 C.F.R. 1.131 or 1.132 should be submitted before final rejection in order to be considered timely. It is anticipated that the next office action will be a final rejection.

Any foreign language documents submitted by applicant have been considered to the extent the short explanation of significance, English abstract or English equivalent allow.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Claims limited to the composition recited by claim 1 (and limited to the enabled waxes absent evidence selection of a particular wax would have within the purview of one of ordinary skill in the art) and methods of using that composition would be allowable over the prior art of record.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M Brunzman whose telephone number is 703-308-3454. The examiner can normally be reached on M, Tu, Th, F; 6:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on 703-308-3823. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

David M Brunzman
Primary Examiner
Art Unit 1755

DMB
August 23, 2002

A handwritten signature in black ink, appearing to be 'DMB', with a long horizontal flourish extending to the right.